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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,920	12/11/2001	Albert C. Ting	VGEN.005A	7542

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EXAMINER

GILPIN, CRYSTAL M

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 08/01/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

NK

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/017,920	TING ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Crystal M Gilpin	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being anticipated by Portney (USPN 6,179,058) in view of Sarfarazi (USPN 6,488,708).

Regarding claims 1, 4, 7, 9, 17 and 19, Portney teaches of an intraocular lens with an optical axis (Fig. 1a, Ref. Num. 32) and a secondary or anterior portion (Fig. 2, Ref. Num. 64) and primary or posterior portion (Fig. 2, Ref. Num. 62) both made of refractive material (Column 2, lines 19-22). The primary or posterior portion has a diameter larger than that of the anterior portion (Column 9, lines 35-36) and a central section (Fig. 2, Ref. Num. 76) that extends radially from the optical axis has a range of negative to positive refractive power, (Column 7, Lines 40-49). Portney lacks the teaching of the of the anterior and posterior optics being configured to move relative to one another in response to the movement of the ciliary muscle. Sarfarazi teaches of an intraocular lens system where the anterior lens is moved toward the posterior lens due to movement of the ciliary muscle to appropriately accommodate vision. Although Sarfarazi does not move both lenses the Examiner contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Portney to have the anterior and posterior lens configured to move relative to one another in response to forces from the ciliary muscle to provide accommodative vision.

Regarding claims 3, 5 and 10, Portney teaches that the anterior portion has a diameter no greater than 7 mm, which includes the range of about 3 mm or less. Portney further teaches that the anterior portion has a diopter range less than 30 diopters, from -2.5 to +2.5, which includes a refractive power of zero (Column 7, Lines 50-58).

Regarding claim 12, either of the primary or secondary viewing elements are implantable and therefore inherently removable.

Regarding claims 13 and 14, Portney teaches that the primary viewing element includes a frame with a narrow recess or groove for the detachable attachment of the secondary viewing element (Column 8, lines 15-18, Fig. 3, Ref. Num. 74)), where the secondary viewing element has a frame attached to it (Fig. 2, Ref. Num. 80).

Regarding claims 2, 8 and 16, Portney discloses an intraocular implant with an secondary or anterior optic with refractive power and a diameter no greater than 7 mm. Portney does not disclose expressly that the diameter is 3 mm or less. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to limit the diameter of the optic to less than 3 mm because Applicant has not disclosed that a diameter of 3 mm or less provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a diameter of less than 7 mm, as long as it is smaller than the primary or posterior optic.

Therefore, it would have been an obvious matter of design choice to modify Portney to obtain the invention as specified in claims 2, 8 and 16.

Regarding claims 6 and 11, Portney discloses an intraocular implant with a posterior

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optic that has a diopter range between  $-10$  and  $+35$  diopters (Column 7, Lines 40-49). Portney does not disclose expressly that the refractive power is about 20 diopters. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to specify the refractive power as about 20 diopters because Applicant has not disclosed that a refractive power of about 20 diopters provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a range of  $-10$  to  $+35$  diopters in order to accommodate the patients focusing needs.

Therefore, it would have been an obvious matter of design choice to modify Portney to obtain the invention as specified in claims 6 and 11.

Regarding claim 15, Portney teaches of an intraocular lens with an optical axis, and a posterior and anterior viewing element (Fig. 2, Ref. Numbers 64 and 62) that have different refractive powers (Column 3, Lines 15-25).

Regarding claim 18, Portney discloses that the anterior optic extends radially, or has a larger diameter than the posterior portion. Portney does not disclose expressly disclose that the posterior optic extends radially, or has a larger diameter, than the anterior portion.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the posterior optic extend radially beyond the anterior optic because Applicant has not disclosed that having light bypass the anterior optic provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform

equally well with the anterior optic extending beyond the posterior optic because the light will still bypass the refractive power of one optic.

Therefore it would have been an obvious matter of design choice to modify the invention of Portney to obtain the invention as specified in claim 18.

### ***Response to Arguments***

Applicant's arguments with respect to the 102(e) and 103(a) rejections of claims 1-14 in view of Portney (USPN 6,179,058) have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments, see Paper No. 10, filed 1 May 2003, with respect to the 103(a) rejection of claims 1, 4, 6, 7, 9 and 11-14 in view of Turley (USPN 4,892,543) have been fully considered and are persuasive. The 103(a) rejections of claims 1, 4, 6, 7, 9 and 11-14 in view of Turley (USPN 4,892,543) have been withdrawn.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crystal M Gilpin whose telephone number is 703-305-8122. The examiner can normally be reached on M-F, 9:00-5:00 (Second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The group fax phone number for the organization where this application or proceeding is assigned are 703-305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

cmg  
July 29, 2003



**Paul B. Prebilic**  
**Primary Examiner**